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In the Supreme Court of the United States

October Term, 1971

No. 71-1499

DEVCON CORPORATION,
Petitioner,

vs.

WOODHILL CHEMICAL SALES CORPORATION,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

HOWARD L. WEINSHENKER
HAL D. COOPER
1111 Leader Building
Cleveland, Ohio 44114
Counsel for Respondent

YOUNT, TAROLLI, WEINSHENKER & COOPER
1111 Leader Building
Cleveland, Ohio 44114
Of Counsel

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-5647

TABLE OF CONTENTS

OPINIONS BELOW 1
JURISDICTION 1
QUESTIONS PRESENTED 2
STATUTORY PROVISIONS INVOLVED 2
STATEMENT OF THE CASE 4
REASONS RELIED ON FOR DENIAL OF THE WRIT 6

1. The Judgment Below is Interlocutory 6
2. There is no Conflict of Decision 6
3. There is no Question of Public Importance 7
4. The Decision of the Court of Appeals is Clearly Correct 8

CONCLUSION 8

TABLE OF AUTHORITIES

Cases

American Construction Co. v. Jacksonville, T&KW Ry. Co., 148 U.S. 372 6
Beckwith, P. D., Inc. v. Commissioner of Patents, 252 U.S. 528 (1920) 7
Delaware & Hudson Canal Co. v. Clark, 80 U.S. (13 Wall.) 311 6
Hamilton-Brown Shoe Company v. Wolf Brothers & Company, 240 U.S. 251 6
Kellogg Co. v. National Biscuit Co., 305 U.S. 11 (1938) 7
Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446 (1911) 7
Warner & Co. v. Eli Lilly & Co., 265 U.S. 526 (1924) 7

Statutes

15 U.S.C. §1052 ..... 3, 8
15 U.S.C. §1115b 3
28 U.S.C. §636 2

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OPINIONS BELOW

Reference to the opinions below appears on pages 1 and 2 of the Petition. The opinion of March 20, 1972 is reported at 173 US PQ 257.

JURISDICTION

The jurisdiction basis is set forth in the Petition at page 2.

QUESTIONS PRESENTED

1. Whether a court of appeals may render judgment of an interlocutory nature on conceded facts without reaching the issue of the propriety of a magistrate's resolution of the evidence.

2. Whether "FIVE MINUTE" can be appropriated as a trademark for an epoxy glue, the principal distinguishing characteristic of which is its five minute setting time.

3. Whether a party can seize upon one of the primary characteristics that make an unpatented commercial product marketable and preempt or limit competitor reference to that characteristic by registering it as a trademark.

STATUTORY PROVISIONS INVOLVED

Petitioner has omitted pertinent portions of both Title 28 and Title 15.

United States Code, Title 28:

§ 636 *Jurisdiction and Powers.*

* * * * *

(b) Any district court of the United States, by the concurrence of a majority of all the judges of such district court, may establish rules pursuant to which any full-time United States magistrate, or, where there is no full-time magistrate reasonably available, any part-time magistrate specially designated by the court, may be assigned within the territorial jurisdiction of such court such additional duties as are not inconsistent with the Constitution and laws of the United States. The additional duties authorized by rule may include, but are not restricted to—

(1) service as a special master in an appropriate civil action, pursuant to the applicable provisions of this title and the Federal Rules of Civil Procedure for the United States district courts;

(2) assistance to a district judge in the conduct of pretrial or discovery proceedings in civil or criminal actions.

United States Code, Title 15:

§ 1052 *Trade-marks registrable on principal register; concurrent registration.*

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

* * * * *

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them . . .

§ 1115b *Remedies - When Conclusive Evidence of Exclusive Right to Use Mark.*

If the right to use the registered mark has become incontestable under section 15 hereof, the registration shall be conclusive evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the affidavit filed under the provisions of said section 15 subject to any conditions or limitations stated therein except when one of the following defenses or defects is established:

* * * * *

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a trade or service mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe to users the goods or services of such party.

STATEMENT OF THE CASE

This is a trademark infringement and unfair competition suit.

Both parties sell fast setting epoxy glues. Petitioner uses the term "FIVE MINUTE" on its package while respondent employs the trademark E-POX-E 5 on its package. Both parties represent that their respective products will set or bond in approximately five minutes, and petitioner's tests confirm the accuracy of respondent's representation (R. 397).

The complaint was filed on April 23, 1971. Petitioner filed its motion for preliminary injunction on November 16, 1971 and a hearing was held before Magistrate Davis on December 21, 1971. At the hearing, physical exhibits and documentary evidence demonstrated that eleven companies including petitioner were currently marketing epoxy glues and using the term "5 minutes" in the advertising of such products (Respondent's Appeal Brief, p. 10).

The evidence introduced at the hearing also included:

(1) Repeated admissions both by petitioner's president (R. 214, 215, 219, 223) and by petitioner's attorney

(R. 454) that five minutes is the setting time of petitioner's epoxy glue.

(2) Documentary examples of petitioner's own advertising in which five minutes was used to describe the setting time of its product (R. 383, 387, 388, 433-438).

(3) The results of tests conducted by petitioner on respondent's product confirming that respondent's epoxy glue also sets in five minutes (R. 281-283, 397).

On December 28, 1971, without notice to either party, the magistrate filed a Memorandum Opinion recommending issuance of the preliminary injunction. Thereafter, and without affording respondent either an opportunity to file objections to the Memorandum Opinion or to be heard, the District Judge signed an order granting the Preliminary Injunction on January 6, 1972. The District Judge made no findings of fact or conclusions of law in support of that order.

On January 11, 1972 respondent filed an appeal to the Court of Appeals for the First Circuit and petitioned for a stay of the injunction pending appeal. The stay was granted following a hearing before Chief Judge Aldrich.

On January 20, 1972 the Court of Appeals for the First Circuit issued a *per curiam* opinion and order continuing the stay until disposition of the appeal.

On March 6, 1972 the appeal was argued.

On March 20, 1972 the Court of Appeals for the First Circuit issued an opinion and judgment vacating the preliminary injunction imposed by the District Court.

REASONS RELIED ON FOR DENIAL OF THE WRIT

1. The Judgment Below is Interlocutory.

This court stated in *American Construction Co. v. Jacksonville, T&KW Ry. Co.*, 148 U.S. 372:

> ". . . this court should not issue a writ of certiorari to review a decree of the circuit court of appeals on appeal from an interlocutory order unless it is necessary to prevent extraordinary inconvenience and embarrassment in the conduct of the cause."

Petitioner has not argued extraordinary inconvenience and embarrassment because it has suffered none such.

In a trademark case, *Hamilton-Brown Shoe Company v. Wolf Brothers & Company*, 240 U.S. 251, this court noted that it had denied an earlier petition for certiorari by Wolf Brothers (complainant) from an interlocutory decree of a court of appeals, stating:

> "The decree that was sought to be reviewed at complainant's instance was not a final one, a fact that of itself alone furnished sufficient ground for the denial of the application. . . ."

Respondent submits that the fact that the decree sought to be reviewed is an interlocutory one is sufficient ground for the denial of the petition.

2. There is no Conflict of Decision.

All courts uniformly and consistently apply the rule of law set forth by this Court in *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. (13 Wall.) 311, that valid trademarks may not be acquired in terms which are:

". . . merely descriptive of an article of trade, of its qualities, ingredients or characteristics."

See also, *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 11 (1938); *Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526 (1924); *P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 528 (1920); *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, 220 U.S. 446 (1911).

Some trademarks which identify time elements, e.g. "minute", "one minute", have been held to be valid trademarks, and others have not, depending on the primary qualities and characteristics of the goods to which the marks are applied.

A difference in result reached does not constitute a conflict in decision. This is the expected consequence of measuring different facts against an accepted rule of law.

3. There is no Question of Public Importance.

There is nothing in petitioner's brief to support the allegation that there exist significant or recurring problems concerning the authority of magistrates.

Even in the decree of which petitioner seeks review, reference to the magistrate was clearly *obiter dictum* and relegated to a footnote. The Court of Appeals decided the case on "hard evidence and not speculation", as represented by "the conceded facts". The Court specifically declined to reach the issue of the propriety of the magistrate's resolution of the evidence. The Court of Appeals discussed the magistrate's resolution of the evidence because it felt that petitioner had not accurately interpreted what the magistrate had concluded.

The magistrate question is therefore hypothetical, not real, involving neither public interest nor general importance.

4. The Decision of the Court of Appeals is Clearly Correct.

The magistrate found that petitioner's product was a "glue which sets in five minutes". Petitioner's president testified that his epoxy glue "hardens", "does set up" and "sets" in "about five minutes" (R. 214, 215, 219, 223) and that the reason he calls the product "5 MINUTE" is because "We're trying to give the customer an idea that it sets up in about five minutes' time" (R. 256). Petitioner has also admitted that the principal characteristic which distinguishes this type of epoxy glue from other epoxy glues is its setting time of five minutes (R. 213).

In view of this Court's prior decisions and the statutory prohibition, 15 U.S.C. § 1052 (e) (1), against exclusive appropriation of terms that are merely descriptive of the product, we submit that the decision of the Court of Appeals is clearly correct.

CONCLUSION

For the foregoing reasons, it is urged that this petition for a writ of certiorari should be denied.

Respectfully submitted,

HOWARD L. WEINSHENKER
HAL D. COOPER
1111 Leader Building
Cleveland, Ohio 44114
Counsel for Respondent

YOUNT, TAROLLI, WEINSHENKER & COOPER
1111 Leader Building
Cleveland, Ohio 44114
(216) 621-2234
Of Counsel